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EXAMINER

ART UNIT PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliance
With 37 CFR 1.192(c)**

Application No.

09/996,244

Applicant(s)

SCHAEFER ET AL.

Examiner

Harvey E. Behrend

Art Unit

3641

NW

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 5/14/04 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☒ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☒ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☒ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☒ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☒ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☒ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

see attachment

As to item (4), the last paragraph of the Summary of the Invention on page 2 of the brief, refers to a rejection under 35 USC 112 first paragraph, such is clearly not a part of the "Summary of the Invention".

The second to the last paragraph of the Summary of the Invention on said page 2 of the brief incorrectly states that the entrapment of the thermal neutrons is verified based on gamma spectrographic analysis (the specification does not use the term "verified").

Instead, the specification presents an Example on pages 7-9 which sets forth applicants procedure for determining the presence of a trapped free thermal neutron in a fullerene, using gamma spectrographic analysis and the conclusion that:

"Evidence that neutrons are trapped in the fullerene molecule consists of the presence of a pure beta emitter in the fullerene that remains after the counts resulting from the gamma emitters have been stripped from the raw data. The pure beta emitter has a half life of about ten minutes. There are very few pure beta particle emitters with a half life anywhere near ten minutes. The rarity of these pure beta emitters, their chemical nature, and the chemical nature of the fullerene all point to the conclusion that they cannot be the source of the pure beta emitter observed in the irradiated fullerene. The only other possible source of the radiation is the decay of free neutrons."

As to item (5), each stated issue should correspond to a separate ground of rejection.

What applicant lists as subissues (i)-(iii) for issue A (top of page 3 of the brief) are not properly a part of the listing of issues (such could be included in the "Arguments" section of the brief).

Applicants statement of issue B (page 3 of the brief) is incorrect.

A proper statement of issue B would be:


"Whether claims 4-8, 10-14, 16-19 are unpatentable under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (see in this respect section 3 on page 2 of the 12/12/03 Office action).

As to item (6b), applicant in the Grouping of the Claims, states in regard to issue B, each claim stands on its own merits, but, fails to present separate arguments for each claim in the Arguments section of the brief.

In further regard to item (9), the brief (see for example, page 8) presents new evidence and, discusses said new evidence. Said discussion refers to this evidence as "four relatively recent experiments" (underlining added), however, it is noted that two of the tests are almost four years old.

First, any new evidence must be submitted in a paper separate from the appeal brief (MPEP 1207).

Second, entry of new evidence in an application on appeal is not a matter of right (MPEP 1207), and, is governed by 37 CFR 1.195. 37 CFR 1.195 states that such evidence will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.


HARVEY E. BEHREND
PRIMARY EXAMINER